

**REMARKS**

In the Final Office Action,<sup>1</sup> the Examiner took the following actions:

- 1) rejected claims 1-15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and
- 2) rejected claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by the combination of “Using the SNAP Development Environment” (“*SNAP*”), “Using the WFT Development Document” (“*ENV*”), and “Developing a WFT Workflow System” (“*WFT*”).<sup>2</sup>

**Rejection of Claims 1-15 under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1-15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. However, to advance prosecution, Applicants propose to amend independent claims 1 and 13 to recite “a tangible machine-readable storage device” and delete “propagating signal” from the specification. Applicants submit that claims 1-15 recite statutory subject matter. Accordingly, Applicants request the Examiner to reconsider and withdraw the rejection of claims 1-15 under 35 U.S.C. § 101.

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

<sup>2</sup> The Examiner cited numerous references but only three of those references, namely, *SNAP*, *ENV*, and *WFT*, were used to support the § 102(b) rejection.

**Rejection of Claims 1-22 Under 35 U.S.C. § 102(b)**

Applicants respectfully traverse the rejection of claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by *SNAP*, *ENV*, and *WFT*.

First, Applicants submit that the Examiner's use of multiple references in support of the rejection under § 102(b) is improper.

A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . . .

35 U.S.C. § 102 (emphasis added). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131, 8th Ed., Rev. 6 (September 2007), quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *SNAP*, *ENV*, and *WFT* are not a single printed publication nor a single prior art reference, and therefore this rejection is based on multiple references.

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

M.P.E.P. § 2131.01, 8th Ed., Rev. 6 (September 2007). However, the Examiner did not combine the multiple cited references for any of the three reasons (i.e., (A), (B), or (C)) listed in M.P.E.P. § 2131.01.

Instead, the Examiner argues that the multiple references “constitute a single reference” (Final Office Action, p. 5) because “the three software modules [described separately in the three references] were part of a single software package offering and that they work together[,] . . . has been designed to seamlessly integrate and inter-operate with all of the others . . . and . . . are designed to be used together” (Final Office Action, p. 11). However, the Examiner has no legal basis (in statute or from case law) for stating that multiple references constitute a single reference for purposes of 35 U.S.C. § 102 when the references disclose software modules that are offered as a single software package or are designed to integrate with one another and used together.

Therefore, the multiple references, *SNAP*, *ENV*, and *WFT*, cannot be combined to support a rejection under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully object to the use of multiple references in support of the rejection under 35 U.S.C. § 102(b). Applicants, nonetheless, argue the merits of this rejection below.

In order to properly establish that the prior art anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Even assuming that *SNAP*, *ENV*, and *WFT* could be considered a single reference, which

Applicants do not concede, such a “reference” does not teach or suggest each and every element of Applicants’ claims.

Independent claim 1 recites a combination including, for example, “a model class associated with the component class, the model class including a model-class class and a model relation class, the model-class class including a model class attribute class, and the model relation class including a model relation role class.” The cited references do not teach or suggest at least these elements of claim 1.

None of the cited references teaches any of the claimed “model class,” “component class,” “model-class class,” “model relation class,” “model class attribute class,” and “model relation role class.”<sup>3</sup> However, the Examiner “note[s] that the naming of the classes may not exactly match those sought to be invented but the . . . classes . . . are . . . disclosed throughout Chapter 3” of *SNAP*. Final Office Action, p. 12. This is incorrect.

Even assuming that the names of the classes in *SNAP* need not match the names of the claimed classes, which Applicants do not concede, claim 1 recites more than mere names of classes. That is, claim 1 also recites relationships between classes. For example, the claimed “model class [is] associated with the component class, the model class includ[es] a model-class class and a model relation class, the model-class class includ[es] a model class attribute class, and the model relation class

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<sup>3</sup> Substantial portions of the cited references are illegible, and therefore Applicants’ characterizations of the cited references set forth herein are based on limited, legible portions of the references. Accordingly, Applicants respectfully request that the Examiner provide more legible copies of the references.

includ[es] a model relation role class,” as recited in claim 1 (emphases added). *SNAP*, as well as *ENV* and *WFT*, fails to teach or suggest any class with these claimed relationships (associations and hierarchical inclusions) to other classes. Therefore, the cited references fails to teach or suggest at least the claimed “model class,” as recited in claim 1. For at least these reasons, the cited references fail to anticipate claim 1.

Independent claims 13 and 16, although different in scope from claim 1, are allowable over the cited references for at least reasons similar to those given for claim 1. In addition, dependent claims 2-12, 14, 15, and 17-22 are allowable over the cited references at least by virtue of their dependence from allowable base claims 1, 13, and 16. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1-22 under 35 U.S.C. § 102(b).

### **Conclusion**

Applicants respectfully request the Examiner to enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-22 in condition for allowance. Applicants submit that the proposed amendments of claims 1 and 13 and amendments to the specification merely address issues under 35 U.S.C. § 101, do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, and are in response to the Examiner’s specific reasons for the rejection under 35 U.S.C. 101. Therefore, this Amendment should allow for immediate action by the Examiner.

Applicants further submit that the entry of the amendments would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

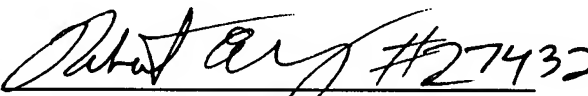
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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